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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,193	09/25/2003	Gary E. Wheat	13DV14196-4	7238

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EXAMINER

MEEKS, TIMOTHY HOWARD

ART UNIT PAPER NUMBER

1762

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/671,193	Applicant(s) WHEAT ET AL.	
	Examiner Timothy H. Meeks	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 16-32 is/are pending in the application.
 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1 and 16-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20030925, 20031126</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1, drawn to an apparatus, classified in class 118, subclass 715.
- II. Claims 16-32, drawn to a method, classified in class 427, subclass 248.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus could be used in a process wherein a material other than inert carrier gas is introduced.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Eric Guttag on 2/7/05 a provisional election was made with traverse to prosecute the invention of Group II, claims 16-32.

Affirmation of this election must be made by applicant in replying to this Office action.

Claim 1 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

Art Unit: 1762

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims require heating to certain temperatures during step (c). It is noted that step (d) requires heating, not step (c).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Pillhoefer et al. (5,455,071).

Pillhoefer discloses a method for introducing inert gas into a container for vapor coating articles with a metallic coating having a base, a top spaced from the base, and a sidewall connecting the top and base wherein a plurality of inert gas streams are introduced proximate the top of the container (figures 1 and 2, col. 5, line 55 to col. 6,

line 5). Please note the angle of the screens in figures 1 and 2 toward the center of the chamber. The plurality of inert gas streams emanating therefrom clearly take a generally curved centripetal (toward the center) path.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pillhoefer et al.

Pillhoefer does not disclose the claimed flow rates for the inert gas. However, Pillhoefer does disclose at the section cited above that the inert gas is introduced to flush the chamber and component. As such the flow rate at which the gas is introduced would affect it's flushing ability and hence it would have been a matter of

routine experimentation to optimize this result effective parameter to values in the claimed range and therefore obvious absent evidence showing a criticality for using the claimed flow rates. Furthermore, it is well settled that "Where principal difference between claimed process and that taught by reference is a temperature difference, it is incumbent upon applicants to establish criticality of that difference." (Ex Parte Khusid, 174 USPQ 59) and because this principal would clearly be applicable to other process parameters such as flow rate, it would have been obvious to use flow rates in the claimed absent evidence showing a criticality for use of the claimed flow rates.

Claims 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pillhoefer et al. in view of Walter (6,203,851).

Pillhoefer discloses introducing the inert gas during a heating of the container but only discloses introducing HCl and hydrogen during the formation of the coating. Therefore, Pillhoefer fails to disclose step (e) of claim 22 of "continuing the flow of the carrier gasto move the metallic coating gas within the coating chamber....so as to deposit a coating on the articles." because no inert carrier gas is introduced during this step. However, because Walter discloses that either hydrogen or inert gas such as Ar can be used as a propellant to be run through metal source and deposit metallic coatings on articles in a container (col. 2, lines 28-42), it would have been obvious to have included at least some inert gas such as argon in the gases of Pillhoefer during coating formation as both are suitable as propellants in vapor coating with metallic coatings in a container. As to claim 26, the particular activators are not disclosed, however, because Walter discloses that ammonium chloride is a suitable activator (col.

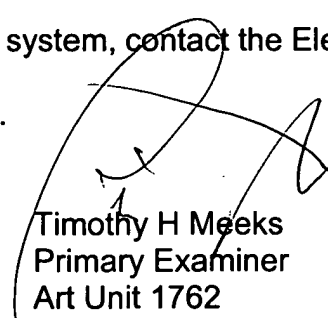
Art Unit: 1762

4, line 15), it would have been obvious to use this activator. Use of the claimed flow rates would have been obvious for the reasons stated above. The claimed temperatures are disclosed at col. 5, lines 10-15 of Pillhoefer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy H. Meeks whose telephone number is (571) 272-1423. The examiner can normally be reached on Mon 6-6 and Tues-Thurs 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Timothy H Meeks
Primary Examiner
Art Unit 1762